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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,258	02/03/2004	James F. Cheatham	21321-0008	2443

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TEAM MANUFACTURING INC.  
Ed Ellis  
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EXAMINER
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VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,258

Applicant(s)

CHEATHAM ET AL.

Examiner

Frank Vanaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **CONTINUATION REISSUE APPLICATIONS**

1. Applicant should be aware of the following guidelines associated with the presentation of a continuation of a reissue application:

#### **Double Patenting**

2. Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the claims of the parent. Where the parent and the continuation reissue applications are examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See MPEP § 804 - § 804.04 as to double patenting rejections. Any terminal disclaimer filed to obviate an obviousness-type double patenting rejection ensures common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

#### **Reference to pending applications**

3. If the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross-reference to the continuation must be effected at the time of allowance of the continuation application by Certificate of Correction.

#### **Oath and/or Declaration**

4. Where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is not to be abandoned, the copy of the consent of the parent reissue application should not be accepted. The copy of the consent of the parent reissue application does not indicate that the assignee has consented to the addition of the new error correction of the continuation reissue application to the original patent. Presumably, a new correction has been added, since the parent reissue application is still pending. OIPE should accord a filing date and send out a notice of missing parts stating that there is no proper consent and setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(e). See MPEP § 1410.01. The copy of the reissue oath/declaration should be accepted by OIPE, since it is a oath/declaration, albeit improper under 35 U.S.C. 251. The examiner

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should reject the claims of the continuation reissue application under 35 U.S.C. 251 as being based on an oath/declaration that does not identify an error being corrected by the continuation reissue application, and should require a new oath/declaration. See MPEP § 1414.

Where a continuation reissue application is filed with a copy of the oath/declaration and assignee consent from the parent reissue application, and the parent reissue application is, or will be abandoned, the copy of the consent should be accepted by both OIPE and the examiner. The reissue oath/declaration should be accepted by OIPE, and the examiner should check to ensure that the oath/declaration identifies an error that is being corrected in the continuation reissue application. See MPEP § 1414. If a preliminary amendment was filed with the continuation reissue application, a supplemental reissue oath/declaration may be required. Pursuant to 37 CFR 1.175 (b)(1), for any error corrected via the preliminary amendment which is not covered by the oath or declaration submitted in the parent reissue application, applicant must submit a supplemental oath/declaration stating that every such error arose without any deceptive intention on the part of the applicant. See MPEP § 1414 and § 1414.01.<

#### **Original Patent**

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. Applicant's desire to wait for a notice of Allowability is noted, however 37 CFR 1.178(a) requires the statement or surrender before allowance.

#### **Preliminary Amendment**

6. The preliminary amendment lacks a statement as required by 37 CFR 1.173(c) which specifically points out the support in the specification for the subject matter of the amendment. Appropriate correction is required.

#### **Declaration**

7. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration submitted with this application, while positively stating the error which arose without deceptive intent, fails to state how the error renders the patent inoperative or invalid as set forth in MPEP 1414(II).

**Recapture of Surrendered Subject Matter**

8. Claims 38-43 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Each claim lacks the recitation of the one piece construction of the chassis, or the method of forming a chassis including a one-piece construction. Each independent claim of the allowed application (08/902,449) included the limitation that the chassis be of one piece. Further, applicant argued in several amendments that this limitation had been specifically added to overcome a rejection or provide a more clearly defined claim. See paper 16 of the '449 application, at page 5 which specifically refers to the addition of this limitation into the independent claims which lacked this limitation, and later again at page 7 wherein the same one-piece feature was again mentioned with respect to the dependent claims. Further still, at paper 9 of the '449 application on page 4, and paper 8 at pages 8 and 9, the addition of the one-piece limitation to define beyond the prior art again discussed. Thus the inclusion in the patented claims of the limitation that the chassis is formed from one piece was not an error.

9. Claims 38-43 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon

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which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Each claim lacks the limitation that the spacers have specifically been coined as set forth in the specification. Each independent claim of the allowed application (08/902,449) included the limitation that the spacers be coined. Further, applicant argued in several amendments that this limitation specifically is pointed out as defining beyond the prior art. See paper 8 of the '449 application, at page 12, wherein the prior art is identified as lacking this limitation, paper 9 at pages 4-5, paper 11, pages 2-8 which goes into substantial detail describing the use of a coined spacer and how the presence of this limitation defines beyond the prior art, and paper 16, including both the amendments to the claims, and the comments on page 5. Thus the inclusion of the limitation in the patented claims that the spacer elements be coined was not an error.

10. Claims 41 and 42 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

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U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 41 and 42 lack the limitation that the spacers surround apertures through which axles are positioned. Each independent claim of the allowed application (08/902,449) included the limitation that the spacers surrounded apertures through which wheel axles are positioned. Further, applicant argued the importance of this limitation during prosecution in paper 16, in the comments on page 5. Thus the inclusion of the limitation in the patented claims that the spacer elements surround an aperture through which an axle is positioned was not an error.

#### **Claim Rejections - 35 USC § 112**

11. Claims 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 40, line 4, it is not clear what particular limitations associated with the term "convenient" are to be attributed to the timing of the formation of the truncated cylinders (see claim 41, line 3 and claim 42, line 4, as well); in claim 40, lines 4-6, it is not clear whether applicant is attempting to incorporate method limitations into an apparatus claim, thus rendering the scope unclear.

#### **Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 38-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soo (US 5,129,663). Soo teaches an in-line skate frame which may be made, comprising a single element, the frame forming a channel with a top, side walls (10) and a bottom, the top including plural flanges (8) for accommodating footwear (9), the side walls extending downwardly from the top and extending in a longitudinal direction of the skate, the frame further including apertures (13) for accommodating skate wheel axles

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for mounting skate wheels (3), the apertures surrounded by spacers extending inwardly from the side walls and having an outer countersunk recess (see figure 5) and a truncated cylindrical shape directed inwardly (14). Benoit fails to specifically teach the material from which the frame is made, however in view of metal having a substantially high strength, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the skate frame from a metal for the purpose of providing the frame with substantially high strength, so as to ensure its longevity under strenuous skating activity.

The reference to Soo fails to specifically refer to the 'convenience' of the time whereat the spacers are formed, however in view of the reference lacking any discussion of difficulty for such a formation (or any discussion of inconvenience in the formation), it is deemed inherent that the spacers are formed at a time 'convenient' to Soo.

14. Claims 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (6,301,771, filed 10/1996) in view of Hilgarth (US 6,015,157, filed 4/1997). Benoit teaches an in-line skate frame and method of making such a frame, comprising either multiple pieces or a single piece of aluminum, the frame forming a channel with a top, side walls (2) and a bottom, the top including plural flanges (3, 4) for accommodating footwear, the side walls extending downwardly from the top and extending in a longitudinal direction of the skate, the frame being formed by a pressing process into an appropriate shape, the frame further including apertures (6) for accommodating skate wheel axles for mounting skate wheels, the apertures surrounded by spacers extending inwardly from the side walls (7) and having a truncated cylindrical shape formed by a pressing process (specifically die forging).

The reference to Benoit fails to specifically refer to the 'convenience' of the time whereat the spacers are formed, however in view of the reference lacking any discussion of difficulty for such a formation (or any discussion of inconvenience in the formation), it is deemed inherent that the spacers are formed at a time 'convenient' to Benoit.



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As regards the provision of wheel axles and wheels (claims 39, 40), each of these elements is very old and well known in the skate making art as being used for a skate, and particularly in that Benoit teaches the skate frame as being adapted to accommodate these elements (col. 3, lines 16-20, col. 3, line 28), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate frame taught by Benoit with an element of footwear, wheels and wheel axles for the purpose of providing a complete and functional skate.

As regards claim 42, the reference to Benoit fails to teach the formation of holes, followed by the formation of the spacers. The reversal of forming steps is not deemed to be beyond the skill of the ordinary practitioner, and in this case, it would have been obvious to first form the holes, and then form the spacers, in order to facilitate and allow the use of plural drilling templates, e.g., having different numbers of wheels, or wheel-spacings, allowing the centering of the die(s) based on a desired hole spacing.

Benoit fails to specifically teach a countersink on the exterior face of the sides. Hilgarth teaches that it is well known to provide a countersink (38) on a skate frame side, with an accompanying inwardly extending truncated cylinder to accommodate an axle end. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the frame side taught by Benoit with a countersink as taught by Hilgarth for the purpose of providing a protected region for the end of the wheel supporting axle, the motivation being expressly set forth in Hilgarth at col. 8, lines 61-63.

### **Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Keiper (US 687,838), Blochinger (US 2,070,646), Miller (US 2,533,277), Monroy et al. (US 5,513,861), Rosso et al. (US 5,590,890), Monroy et al. (US 6,142,490), and Benoit (US 6,293,563) teach skate and wheel-accommodating structures.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

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A response to this action should be mailed to:

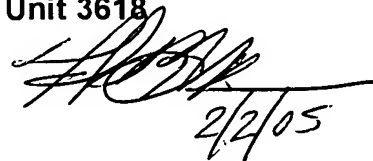
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**F. VANAMAN**  
Primary Examiner  
Art Unit 3618



2/2/05